

REMARKS

Claims 1-17 and 32-44 are currently pending in the application. Applicant has amended claims 1, 4, 12, 15 and 35. Applicant requests reconsideration of the application in light of the following remarks.

Telephone Interview

Applicants attorney wishes to thank the Examiner for his courtesy and time during a telephone interview between Applicant's attorney Kenneth C. Booth, Examiner Graham, and Supervisory Patent Examiner Sough that was held on July 6, 2004. In that telephone conference cited patent references to Norris, and Donohue et al. were specifically discussed in conjunction with the pending independent claims of the present invention. An understanding was reached between the Examiners and Applicant's attorney that the claims in their form prior to the present amendment were sufficient to overcome the rejection and that amendment was not needed or required. The distinctions discussed specifically related to those same distinctions that have been discussed in the previous Office Action responses filed by Applicant relating to money received and identified by the investment machine, as opposed to just being transferred from one account to another through a bank terminal, and to the investor selecting current investment preferences at the time the money is received.

The Examiners indicated that a short response is all that is required here so that Examiner Graham can reconsider the rejection and determine if a more appropriate reference is available. Although it was not required for patentability by the Examiners, Applicant has elected herein to amend the claims to further clarify the claim language and restate the invention in different terms. Applicant hereby declares that these amendments are not made for the purpose of patentability and should not be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

Rejections under 35 U.S.C. §102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1-7, 10-11, 12-13, 15-17, 23-33, 35-41, and 44 were rejected under 35 U.S.C. § 102(e) as being anticipated by Norris U.S. Patent No. 6,105,007. Applicants respectfully traverse this rejection and request reconsideration of the claims.

Each of the independent claims of the application recite a “money receiver” to receive and identify or count money in the form of a coin or a bill. This claim element was already recited in the claims prior to the current amendment, and was expressly included within independent claims 32 and 35. Norris does not disclose any coin or bill receiver. As components of it’s system Norris lists, at col. 9, lines 7-18, referring to FIGS. 2 and 3:

A kiosk is basically a housing that can contain all of the equipment for a borrower to use in contacting and communicating with a remote, centrally located transaction processor 10, or, alternatively, kiosk 40 can contain processor 10. Kiosk 40 includes monitor 50 with touch screen capability, a magnetic bank card reader 70 that enables a bank card to be read to identify an applicant as well as the applicant’s bank and corresponding checking account, a magnetically encrypted card reader, an internal printer with communications link (not shown in FIGS. 2 and 3) and, in a preferred embodiment, electronic signature pad 100 and associated electronic pen 105 and a security camera 110.

There is no mention of any coin or bill receiver or anything like it. The system of Norris is designed merely to transfer money between accounts. The most recent office action relies upon col. 3, line 60 and col. 9, line 65 to col. 10, line 5 for further support. In those sections, Norris mentions as additional capabilities of the system: depositing and withdrawing money, arranging for automatic deposits to and withdrawals from accounts, funding individual retirement accounts, and purchasing certificates of deposits, savings bonds, and mutual fund shares. None of these functions, however, requires or necessarily includes a coin or bill

receiver. Depositing and withdrawing money, similar to the automatic deposits and withdrawals, may be done between accounts by depositing money from one account into another account or withdrawing money from an account to place it into another account. Alternatively, though it is not disclosed or identified in Norris, deposits may be made by placing money in an envelope with a dollar amount written on a deposit slip. This amount may then later be counted and confirmed by a teller before the money is actually deposited into the account. Known conventional banking machines themselves do not count or otherwise identify the money being deposited in those cases.

Applicant's invention is particularly advantageous in the industry and provides unique utility in that it provides what prior to the invention was not available - an investment machine through which investors can deposit loose change and bills in accordance with current investment preferences. Applicant's invention encourages the general public to invest change rather than keep it in their wallets where it will likely be spent. Further, Applicant's invention allows the user to invest the money in a way the investor wants to invest it.

Applicants respectfully request that the anticipation rejections of claims 1-7, 10-11, 12-13, 15-17, 23-33, 35-41, and 44 be withdrawn.

Rejections under 35 U.S.C. 103

To establish a *prima facie* case of obviousness under 35 U.S.C. '103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP 2143.

Claims 8-9, 14, 34 and 42-43

Claims 8-9, 14, 34 and 42-43 were rejected under 35 U.S.C. '103(a) as being unpatentable over Norris. Applicants respectfully traverse this rejection and request reconsideration of the claims.

Claims 8-9, 14, 34 and 42-43 are allowable over Norris, among other reasons, for depending from allowable independent claims. The Office Action acknowledges that Norris “fails to teach the advertising information is selected on the basis of one or more of an investor’s investment activities, an investor’s personal information, a location at which the investment machine is located and an identity of a sponsor of the investment machine.” Applicant notes, however, that Norris also fails to disclose any advertising. The Office Action states that in light of Norris it would be obvious to select advertising information based upon the claimed criteria. However, because there is no teaching or suggestion in Norris to include any advertising information at all, choosing advertising information for the investment machine based upon specific criteria would also not be obvious. To support an obviousness rejection, there must be some suggestion and motivation in the cited reference or in the known prior art to make the claimed combination. No such evidence was cited indicating a suggestion or motivation to include advertising on an investment machine. Accordingly, claims 8, 9, 42 and 43 are further allowable over Norris. Applicants respectfully request that the obviousness rejections of claims 8-9, 14, 34 and 42-43 be withdrawn.

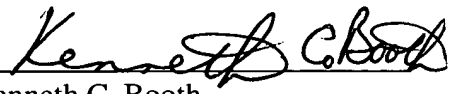
CONCLUSION

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. It is requested that a one (1)-month extension of time be granted for the filing of this response, and the appropriate extension filing fee of \$55 is enclosed herewith.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

Date: July 12, 2004,

By 
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